

## REMARKS

In this RCE, Claims 1-2, 4-8, 14-35, 37-41, 45-53, 57-61, 63-65, 67-72, 74-75, 103-119, and 128-135 are amended; no claims are added or canceled. Claims 76-77 and 79-102 remain withdrawn. Thus, Claims 1-2, 4-8, 14-35, 37-41, 45-53, 57-61, 63-65, 67-72, 74-75, 103-119, and 128-135 are pending. No new matter has been added. Each issue raised in the Final Office Action mailed July 20, 2011 is addressed below.

### I. REJECTIONS BASED ON THE CITED ART

#### A. REJECTIONS BASED ON COMBINATION OF THE KITANI REFERENCES

All independent Claims remain rejected under a combination of U.S. Pat. Pub. 2001/0019612 ("Kitani '612") and U.S. Pat. Pub. 2003/0231869 ("Kitani '869"). As explained below, Applicants respectfully submit that the Final Office Action fails to establish a *prima facie* case of obviousness as there is no motivation to combine the references, and no rationales to support rejections based on a combination of the references, through application of the KSR decision by the Supreme Court.

The rationale for the combination of Kitani '612 and Kitani '869 is stated in the Final Office Action at pages 4-5 as the following (with material added in brackets for clarity):

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings in Kitani 869 in the PC end as taught in Kitani [Kitani '612] in order to allow the operator of the PC [to] play back the scene data during the serialization thus enhancing the interface of the sorting process.

Because of the structure of serialization apparatus 51 as disclosed in Kitani '612, the motivation to combine stated above makes no sense, and no one skilled in the art would make such a

combination. To see this, consider paragraphs [0095]-[0098] of Kitani '612 (the paragraphs cited in the Final Office Action) with respect to Fig. 8 of Kitani '612. An annotated copy of Fig. 8 is attached to this reply as Exhibit A; a clean copy of Fig. 8 is also attached, for the Examiner's convenience, as Exhibit B.

Exhibit A clearly illustrates the portions of Fig. 8 performed by motion picture projector 52 and serialization apparatus 51, and clearly illustrates the data conversion processes that take place under Kitani's scheme to keep copies of pristine DVDs containing motion pictures out of the hands of nefarious individuals.

In particular, at some point prior to projection by motion picture projector 52, serialization apparatus 51 contains unencrypted, serial data 41 that could potentially be shown by display interface 65 (not depicted in Fig. 8; see paragraph [0091]). There is absolutely no need, as alleged by the Final Office Action, for one skilled in the art to somehow incorporate disk player 40 shown in Fig. 17 of Kitani '869 into serialization apparatus 51 of Kitani '612, because decryption processing section 41 provided by disk player 40 is unnecessary; such decryption abilities have already been placed into serialization apparatus 51.

Similarly, one skilled in the art would not look to combine the teachings of Kitani '869 and Kitani '612, because doing so would unnecessarily duplicate pre-existing hardware and software, for which no rational motivation exists. Making the proposed combination would increase the costs of, and thus the price of, serialization apparatus 51.

Additionally, the reasoning above supports a conclusion that none of the rationales articulated by the Office in "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex," 72 Fed. Reg. 57526-57535 (Oct. 10, 2007) would support a rejection of the claims. According to

these guidelines at page 57529, the rationales supporting an obviousness finding are the following:

- A. Combining prior art elements according to known methods to yield predictable results;
- B. Simple substitution of one known element for another to obtain predictable results;
- C. Use of known technique to improve similar devices (methods, or products) in the same way;
- D. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- E. "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- F. Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- G. Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Each of the above rationales is based in part on the logical premise that an artisan would create novel, but obvious, inventions by following paths that reasonably or predictably lead to success. Inherent in all rationales is that through a combination of the references, some type of benefit (such as "predictable results," an "improvement," "a reasonable expectation of success," "design incentives," or "market forces") is achieved. No benefit of any kind is afforded by the combination of Kitani '869 and Kitani '612.

Applicants thus respectfully request reconsideration and withdrawal of all rejections based on the combination of Kitani '869 and Kitani '612.

## **B. THE PATENTABILITY OF THE INDEPENDENT CLAIMS EVEN IF THE KITANI REFERENCES ARE SOMEHOW COMBINED**

Each of the current independent Claims contains features not found in the cited art, even with respect to the mistaken combination of the Kitani references. Each of the current independent Claims is discussed below.

### **1. Current Independent Claims 1, 45, 128, and 134**

**Current independent Claim 1** recites the following (emphasis added):

Apparatus, comprising:  
a media reader having a read element capable of being communicatively coupled to a DVD, wherein the DVD is compliant with the CSS specifications and contains scrambled digital content;  
**a storage element including a storage input disposed for receiving the scrambled digital content from the media reader, the storage element configured to non-evanescently store the scrambled digital content using a storage technique substantially different from the DVD without descrambling the scrambled digital content; and**  
a playback device coupled to the storage element, the playback device comprising:  
a playback input disposed for receiving the scrambled digital content, the scrambled digital content received at the playback input scrambled in accordance with a content scramble system (CSS);  
a descrambler, for descrambling the scrambled digital content into unscrambled digital content;  
a decoder, coupled to the descrambler, for decompressing the unscrambled digital content into a media stream; and  
an output element, coupled to the decoder, configured to output the media stream.

Similarly, current independent Claim 45 includes the following feature:

**non-evanescently storing the scrambled digital content in a protected form using a storage mechanism different from the DVD without descrambling the scrambled digital content;**

Similarly, current independent Claim 128 includes the following feature:

**a storage element for non-evanescently storing scrambled digital content extracted from a DVD, wherein the scrambled digital content is stored using a technique substantially different from the DVD without descrambling the scrambled digital content, wherein the scrambled digital content is protected by a content scramble system (CSS), and wherein the storage element having storage output for sending the scrambled digital content;**

And finally, current independent Claim 134 includes the following feature:

**accessing the stored scrambled digital content, wherein the stored scrambled digital content having been extracted from a DVD compliant with content scramble system (CSS) specifications, wherein the stored scrambled digital content is stored using a technique substantially different from the DVD without descrambling the scrambled digital content, and wherein the stored scrambled digital content is protected by the CSS;**

As shown above, each of current independent Claims 1, 45, 128, and 134 recites the storage of scrambled digital content “**without descrambling the scrambled digital content.**” However, as shown by Fig. 8 (see Exhibit A), serialization apparatus 51 of Kitani ‘612 stores both encrypted and unencrypted (or de-scrambled) digital content. Thus, even if Kitani ‘612 and Kitani ‘689 were combinable, the combination would fail to disclose or suggest storage of scrambled digital content “without descrambling the scrambled digital content” as required by current independent Claims 1, 45, 128, and 134.

Additionally, no combination of one or more of the other cited references:

1. U.S. Patent 6,523,113 (“Wehrenberg”);
2. U.S. Patent 6,353,540 (“Akiba”);
3. U.S. Pat. Pub. 2001/0014946 (“Ichinoi”);
4. U.S. Pat. Pub. 2004/0001704 (“Chan”);
5. U.S. Pat. Pub. 2004/0033061 (“Hughes”);
6. U.S. Pat. Pub. 2003/0110263 (“Shillo”); and
7. U.S. Pat. Pub. 2003/0226029 (“Porter”),

cures the deficiencies of Kitani ‘612 and Kitani ‘869. Thus, Applicants respectfully submit each of current independent Claims 1, 45, 128, and 134, and each claim dependent upon one of current

independent Claims 1, 45, 128, and 134, is allowable over the cited art.

## 2. Current Independent Claim 112

Current independent Claim 112 recites the following (emphasis added):

A media playback device, comprising:

a network connection for receiving scrambled digital content from a remote media storage device, the scrambled digital content extracted from a DVD and scrambled in accordance with a content scramble system (CSS);

a CSS descrambler, coupled to the network connection, for processing the scrambled digital content into unscrambled digital content;

**a decoder, coupled to the CSS descrambler, for decompressing at least a portion of the unscrambled digital content into a media stream; and**

**an output element, for outputting the media stream to a presentation device,**

**wherein the media stream comprises a signal in compliance with a standard for protected signals specified by the CSS procedural specifications.**

Current independent Claim 112 includes the feature of “an output element, for outputting the media stream to a presentation device, wherein the media stream comprises a signal in compliance with a standard for protected signals specified by the CSS procedural specifications.”

No combination of the cited references discloses or suggests this. Whereas Kitani ‘612 makes reference to the content scramble system (“CSS”) (see Kitani ‘612 at paragraphs [0084], [0096], [0097], [0102], and [0111]), Kitani ‘612 references CSS to describe a particular method in which encrypted data is stored, without regard to how data in a media stream may be protected in signal form. For example, Kitani ‘612 at paragraph [0097] refers to “encrypted serial video data 80 stored in the hard disk drive 73, by means of the CSS, thus preparing the serial video data.”

The Final Office Action at page 11 asserts that Kitani ’869 at Fig. 17 and paragraphs

[0059]-[0060] provides the output element that outputs a signal in compliance with a standard for protected signals specified by the CSS procedural specifications. This is incorrect. Figure 17 discloses unprotected analog video and audio signals in a disk player. Paragraphs [0059]-[0060] describe a separate disk drive and the so-called “CSS discrimination circuit” is used to detect flag information and key information with respect to a DVD (see Figs. 7-8).

No combination of one or more of the other cited references cures this deficiency. Accordingly, Applicants respectfully submit current independent Claim 112, as well as all claims dependent upon current independent Claim 112, are allowable over the cited art.

## II. CONCLUSION

The pending claims not discussed so far are dependent claims that depend on an independent claim that is discussed above. Because each of the dependent claims includes the limitations of one of the independent claims, the dependent claims are patentable for at least those reasons the independent claims are patentable. Removal of the rejections with respect to the dependent claims and allowance of the dependent claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. Due to the fundamental difference already identified, a separate discussion of those limitations is not included at this time.

For the reasons set forth above, Applicants respectfully submit that all pending claims are patentable over the art of record, including any art cited but not applied. Accordingly, allowance of all claims is hereby respectfully solicited.

The Examiner respectfully requested to contact the undersigned by telephone if it

believed that such contact would further the examination of the subject application.

Please charge any shortages or credit any overages to Deposit Account No. 50-5592.

Respectfully submitted,

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FIG. 8

